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Corporation

Page 1 of 8

January 19, 2005

**RE: Reply**

Application of: Heckel A. et al.

Art Unit:

Serial No.: 10/624,983

Examiner:

Conf. No.: 4832

Filed: July 22, 2003

For: INDOLINONE DERIVATIVES SUBSTITUTED IN THE 6 POSITION,  
THE PREPARATION THEREOF AND THEIR USE AS PHARMACEUTICAL  
COMPOSITIONS

Docket No.: 1/1373

Susan K. Pocchiari, Ph.D.  
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900 Ridgebury Rd/P.O. Box 368  
Ridgefield, CT 06877-0368

Dear Sir:

Please find transmitted herewith a Certificate of Transmission, a Petition  
Requesting Withdrawal of Notice of Incomplete NonProvisional Application  
Under 37 CFR §1.181 (2 pages in duplicate), a copy of the Stamped Return Post  
Card (1 page), and a copy of the Notice of Incomplete NonProvisional  
Application (2 pages).

The Commissioner is hereby authorized to charge or credit any fee which may be  
required to Deposit Account No. 02-2955.

Respectfully submitted,

*Susan K. Pocchiari*  
Susan K. Pocchiari  
Reg. No. 45,016

Certificate of Transmission under 37 CFR §1.8  
I hereby certify that this correspondence is being  
facsimile transmitted to the United States Patent and  
Trademark Office on January 19, 2005

*Susan K. Pocchiari*  
By: Susan K. Pocchiari  
Reg. No. 45,016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application of : Heckel, A. et al. ) Art Unit:  
Serial No. : 10/624,983 ) Examiner:  
Confirmation No. : 4832  
Filed : July 22, 2003  
Docket No. : 1/1373  
For : INDOLINONE DERIVATIVES SUBSTITUTED IN THE 6 POSITION,  
THE PREPARATION THEREOF AND THEIR USE AS  
PHARMACEUTICAL COMPOSITIONS

RECEIVED  
CENTRAL FAX CENTER  
JAN 19 2005

**Mail Stop Petitions**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION REQUESTING WITHDRAWAL OF NOTICE OF  
INCOMPLETE NONPROVISIONAL APPLICATION UNDER 37 CFR §1.181**

Sir:

Attorney for Applicants respectfully petitions under 37 CFR §1.181 that the Notice of Incomplete Nonprovisional Application dated October 21, 2004 be withdrawn and that a filing date of July 22, 2003 be granted for the above-identified application.

**Statement of Facts**

On July 22, 2003, Attorney for Applicants filed, *inter alia*, the following documents: (1) the above-identified nonprovisional application; (2) a Certified Copy of Priority Document DE 102 33 366.1; and (3) a Verified English Translation of U.S. Provisional Application No. 60/403,106 to which the above-identified application also claims priority. Included herewith is a copy of the Return Postcard which is date stamped by the USPTO listing the above items. Item 1, the above-identified nonprovisional application, was filed in the German language. The above-identified nonprovisional application, as originally filed with the USPTO, comprised a specification as prescribed by 35 U.S.C. §112 containing a description pursuant to §1.71 and nineteen (19) claims contained on pages 286-344 of the specification under the section entitled "Patentansprüche", *i.e.*,

"Patent claims". In the Notice of Incomplete Nonprovisional Application, the OIPE stated that the specification of the above-identified application did not include at least one claim. Included herewith is a copy of the Notice of Incomplete Nonprovisional Application.

#### **Discussion**


Attorney for Applicants respectfully submits that the above-identified application, as originally filed in German, comprised a specification as prescribed by 35 U.S.C. §112 containing a description pursuant to §1.71 and at least one claim pursuant to §1.75. No drawings were required by §1.81(a). Thus, this application met all filing requirements as of July 22, 2003.

#### **Action Requested**

Withdrawal of the Notice of Incomplete Nonprovisional Application and grant of a filing date of July 22, 2003 for the above-identified application is respectfully requested.

The surcharge set forth in 37 CFR 1.17(h) for Petitions to the Commissioner is \$130.00. The Commissioner is hereby authorized to charge any fee which may be required, and to credit any overpayment, to Deposit Account No. 02-2955. A duplicate of this paper is enclosed.

Respectfully submitted,



Susan K. Pocchiari  
Attorney for Applicant(s)  
Reg. No. 45,016

Boehringer Ingelheim Corporation  
Patent Department  
900 Ridgebury Road  
P.O. Box 368  
Ridgefield, CT 06877  
Tel: (203) 798-5648  
Date: January 19, 2005

JAN 19 2005



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/624,983	07/22/2003	Armin Heckel	1/1373

CONFIRMATION NO. 4832

28501

BOEHRINGER INGELHEIM CORPORATION  
900 RIDGEBURY ROAD  
P. O. BOX 368  
RIDGEFIELD, CT 06877

## FORMALITIES LETTER

OC000000014158326\*

Date Mailed: 10/21/2004

## NOTICE OF INCOMPLETE NONPROVISIONAL APPLICATION

## FILED UNDER 37 CFR 1.53(b)

A filing date has NOT been accorded to the above-identified application papers for the reason(s) indicated below.

All of the items noted below and a newly executed oath or declaration covering the items must be submitted within **TWO MONTHS** of the date of this Notice, unless otherwise indicated, or proceedings on the application will be terminated (37 CFR 1.53(e)). Replies should be mailed to: Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

The filing date will be the date of receipt of all items required below, unless otherwise indicated. Any assertions that the item(s) required below were submitted, or are not necessary for a filing date, must be by way of petition directed to the attention of the Office of Petitions accompanied by the \$130.00 petition fee (37 CFR 1.17(h)). If the petition states that the application is entitled to a filing date, a request for a refund of the petition fee may be included in the petition. Petitions should be mailed to: Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

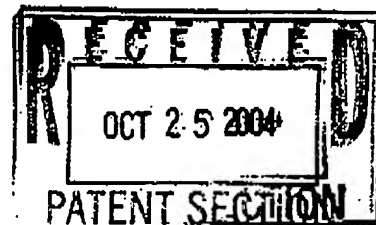
- The specification does not include at least one claim.  
*A complete specification as prescribed by 35 U.S.C. 112 is required.*
- The oath or declaration is missing.  
*A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.*
- Late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of \$130 was not received.

**SUMMARY OF FEES DUE:**

Total additional fee(s) required for this application is \$130 for a Large Entity

- \$130 Late oath or declaration Surcharge.

Replies should be mailed to: Mail Stop Missing Parts  
Commissioner for Patents



P.O. Box 1450  
Alexandria VA 22313-1450

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*A copy of this notice **MUST** be returned with the reply.*



Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 1 - ATTORNEY/APPLICANT COPY

SKP

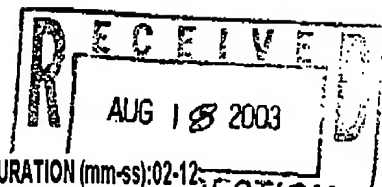
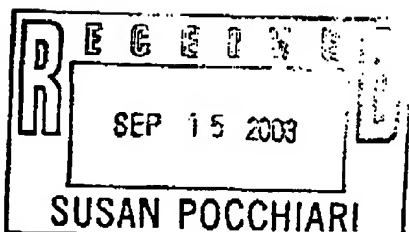
APPLICANT(S): Armin HECKEL et al  
SERIAL NO.: to be assigned  
CONFIRMATION NO.: to be assigned  
FILING DATE: July 22, 2003  
DOCKET NO.: 1/1373  
TITLE: INDOLINONE  
DERIVATIVES SUBSTITUTED IN THE 6  
POSITION, THE PREPARATION THEREOF AND  
THEIR USE AS PHARMACEUTICAL  
COMPOSITIONS

IN CONNECTION WITH THE ABOVE CASE,  
PLEASE DATE STAMP TO ACKNOWLEDGE  
RECEIPT OF THE DOCUMENTS LISTED BELOW,  
AND RETURN TO ADDRESSEE.

1. Utility Patent Application Transmittal (1 page);
2. Fee Transmittal (1 page in triplicate);
3. Specification (345 pages);
4. Certified Copy of Priority Document #10233366.1;  
and
5. Verified English Translation of 60/403,106.
6. Application Data Sheet (6 pages)

Express Mailed  
July 22, 2003  
EV 248 003 871 US

16018 U.S. PTO  
10/624983  
07/22/03



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